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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,248	01/08/2004	David T. Green	1253 CPCNF3C2	6754
50855	7590	06/03/2009		
Tyco Healthcare Group LP 60 MIDDLETOWN AVENUE NORTH HAVEN, CT 06473			EXAMINER NASH, BRIAN D	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 06/03/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,248	<b>Applicant(s)</b> GREEN ET AL.	
	<b>Examiner</b> Brian Nash	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Examiner's Comments***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/2009 has been entered. The pending claims are now 2-10.

2. The Examiner notes that the office action below may reference support found in the cited prior art by indicating element numbers, figures or by pointing out a specific paragraph (PAR) number in which support can be found. The PAR number referenced corresponds to paragraph number beginning in the "Detailed Description" of the disclosure unless otherwise noted.

3. The Examiner notes that a new rejection under 112, second paragraph is made below in order for the claims to more clearly define the difference between the "first" and "second" positions.

Additionally noted and mentioned in the Examiner's Response to Arguments in the previous office action, movement of the control member from a first and second position, e.g. rotation of the control member about the longitudinal axis, can rotate the staple storage portion about the longitudinal axis thereby reading on the claimed limitation of the control member effecting movement of the staple storage portion from a first position to a second position.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 8 and 10, the terminology "axially offset from the longitudinal axis" with regard to the second position of the staple storage portion is indefinite because it is not clear what applicant is

Art Unit: 3721

claiming or what limitations are encompassed by the claim. Specifically, movement of the staple storage portion and/or rotation of the staple storage portion about the longitudinal axis has not been claimed or defined with respect to the proximal (handle portion) end of the stapler and since the claim has been interpreted in the broadest reasonable manner rotation of the entire storage portion about the longitudinal axis anticipates the claim language of "axially offset". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,728,020 to Green et al. Green et al shows the same apparatus for applying surgical fasteners.

With respect to claims 2 and 8-10, an elongate member (100) defining a longitudinal axis (102), a staple storage portion (280) attached to a distal portion of the elongate member and being movable between two positions with respect to the longitudinal axis defined by the elongate member, a control member capable of rotating the elongate member about the longitudinal axis and thereby effecting movement of the staple storage portion located at the distal end of the elongate member (lock ring 190, fig. 1, i.e. 190 controls whether shaft member 100 can rotate between a plurality of positions about axis 102), an advancing mechanism (70) capable of advancing surgical fasteners through the staple storage portion and an anvil (290). As seen by Green (fig. 1, dashed lines), the storage portion (280) can be rotated between a plurality of positions with respect to the longitudinal axis (102). Also shown by Green is that rotation of the control member (190) displaces the control unit itself along the longitudinal axis (PAR 18, "...190 is shifted in the distal direction...").

With respect to claim 3, the apparatus having a frame and handle assembly (20, fig. 1), the assembly has a stationary member and a pivotal member (70).

Art Unit: 3721

With respect to claims 4 and 5, the apparatus of Green et al discharges surgical fasteners when the handle member (70) is squeezed by an operator, i.e. pivotal member pivots between positions. The Examiner further notes that handle member can be partially pivoted or fully pivoted, i.e. moved from a first to a second position.

With respect to claims 6 and 7, the staple storage portion (280) includes a staple cartridge (210) removably attached to the staple support member.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Friday from 8 a.m. to 4 p.m.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see [www.uspto.gov](http://www.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Brian D. Nash/  
Primary Examiner, Art Unit 3721

6/2/2009